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Date: 1/23/06Casey L. Martin
Casey L. Martin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Erin M. Bourke-Dunphy, *et al.*

Examiner: Qamrun Nahar

Serial No: 09/726,111

Art Unit: 2191

Filing Date: November 29, 2000

Title: METHOD AND SOFTWARE TOOLS FOR INTELLIGENT OPERATING SYSTEM
INSTALLATION

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

Appellants' representative submits this brief in connection with an appeal of the above-identified patent application. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP169US].

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I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 1-48 are currently pending in the subject application and are presently under consideration. Claims 1-48 stand rejected by the Examiner. The rejection of claims 1-48 is being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No claim amendments have been entered subsequent to the Final Office Action dated August 25, 2005.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 1**

Independent claim 1 recites a software tool for installing a software component on a server computer system, comprising: a user interface component that renders a plurality of setup prompts to a user and obtains a user command, and a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, selectively provides at least one setup prompt to the user interface component according to the attribute, and selectively installs the software component on the computer system according to the user command. (See *e.g.*, page 14, lines 4 - 22, page 15, lines 3-7).

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B. Independent Claim 14

Independent claim 14 recites a software setup tool for performing a setup operation in a server computer system, comprising: a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, and selectively provides one of standard prompting and special prompting to a user according to the attribute, and a user interface component that renders a plurality of setup prompts to a user and obtains at least one setup parameter. (*See e.g.*, page 14, lines 4-6, page 14, lines 14-22).

C. Independent Claim 21

Independent claim 21 recites a method of performing a setup operation in a server computer system, comprising: sensing an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, and selectively providing one of standard prompting and special prompting to a user in association with the setup operation according to the attribute. (*See e.g.*, page 8, lines 14-29).

D. Independent Claim 28

Independent claim 28 recites a computer-readable medium comprising computer-executable instructions for performing a setup operation of a server computer system: sensing an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, and selectively providing one of standard prompting and special prompting to a user in association with the setup operation according to the attribute. (*See e.g.*, page 14, line 16 – page 15, line 21, page 18, lines 6-9).

E. Independent Claim 35

Independent claim 35 recites a software tool for performing a setup operation in a server computer system, comprising: means for sensing an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, and means for selectively providing one of standard

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prompting and special prompting to a user in association with the setup operation according to the attribute. (See *e.g.*, page 15, lines 8-25).

F. Independent Claim 39

Independent claim 39 recites a data packet adapted to be transmitted between at least two server processes, comprising: a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package and selectively provides one of standard prompting and special prompting to a user according to the attribute, and a user interface component that renders a plurality of setup prompts to a user and obtains at least one setup parameter. (See *e.g.*, page 6, lines 20-29, page 15, lines 8-25).

G. Independent Claim 40

Independent claim 40 recites a system that facilitates an installation of a server operating system, comprising: a setup component that senses an attribute of a registry associated with the server operating system, and in accordance with the attribute, selectively provides at least one of standard prompts for loading a standard functionality installation of server components and special prompts for loading a special lower functionality installation of server components, and a user interface component that renders at least one of the standard prompts and the special prompts, and receives at least one setup parameter. (See *e.g.*, page 15, lines 8-25).

VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A. Claims 1-40, 42 and 45-48 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jones *et al.* (US 5,666,501).

B. Claims 41, 43 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jones *et al.* (US 5,666,501) in view of Kenner (US 6,314,565).

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VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**A. Rejection of Claims 1-40, 42 and 45-48 Under 35 U.S.C. §102(b)**

Claims 1-40, 42 and 45-48 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jones *et al.* (US 5,666,501). Reversal of this rejection is requested for at least the following reasons. Jones *et al.* does not disclose or suggest each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The claimed invention relates to a software tool and methodology for installing a software component or an operating system on a server computer system or computer network. In particular, independent claims 1, 14, 21, 28, 35, 39 and 40 recite similar limitations, namely *a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, selectively provides at least one setup prompt to the user interface component according to the attribute, and selectively installs the software component on the computer system according to the user command.* Jones, *et al.* does not disclose or suggest these novel aspects of appellants' claimed invention.

More particularly, Jones, *et al.* does not disclose or suggest *a setup component that senses an attribute of a registry of the server computer system*, as recited in independent claim 1. The Final Office Action contends that at col. 2, lines 7-12, col. 3, lines 28-37, col. 3, lines 28-37 and col. 3, line 59-col. 4, line 15 it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system; that is, a registry maintains information on installed components. Therefore, in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not

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installed yet. (See Final Office Action dated August 25, 2005, page 4). Appellants respectfully disagree. Jones, *et al.* relates to a method for installing software from a second machine to a first machine in a distributed network. A graphical user interface (GUI) provides numerous selectable options that enable a user to manually select the software from various source media (local and/or remote) and to manually choose from software bundles of a selected source media. All or part of the software of a selected bundle can also be manually chosen by the user for install. Jones, *et al.*, at col. 2, lines 7-12, provides that if a software bundle of objects is selected, the method disclosed by the cited document proceeds to install an intersection of the software items of the source object and the software items of the selected bundle object. Col. 3, lines 28-37, further provides that each bundle of software can contain a list of software items embodied as a subset of the selected source object and additionally, that each software bundle can contain installable software items located on separate source objects. Consequently, according to the cited passage, depending on whether all the software items listed in a bundle are available in the particular source object, a given bundle can be either a subset or a superset of that particular source object. In addition, col. 3, line 59-col. 4, line 15, discloses that display controls allow a user to control and manipulate the contents of a panel wherein the user can apply controls to a single item in the panel, highlight or select items in the panel, or select all the items in the panel. Further, the noted passage provides that a first display control can be used to expand the items in the panel to show available product options, a second display control can be employed to sort the contents of the panel by type, date, name, or any other attribute, and a third display control can be utilized to search the contents of the panel based on type, date, name, or any other attribute.

It would appear that the cited reference provides a GUI that presents numerous options that must be selected by the user for loading software from the remote computer to the local computer. Appellants' claimed invention provides for accessing a registry or registry key such that installation processes are more fully automated with limited user interaction by way of the prompts. Registry access facilitates background decision-making and processing by the software tool such that based on the registry information, the software tool provides *...a setup component that senses an attribute of a registry and ...selectively provides at least one setup prompt...according to the attribute....* The setup component then, in response to the user's command, selectively installs the software component on the computer system.

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Moreover, Jones *et al.* does not teach or suggest *prompts* as understood in the art, but simply presents all of the installation *options* to the user such that user interaction is required for all aspects of the installation to occur. Once the user selects only one source object (FIG. 2, panel 210), the GUI presents the software bundles associated with the source object. Thereafter, the GUI can then present the software files in that bundle (FIG. 2, panel 240). The user can scroll through the list of files provided in panel 240 and select files for installation. Thus, Jones *et al.* teaches that the user must manually make software and/or file selections from a plurality of presented options in order for the installation to occur.

Whereas, the software tool of appellants' claimed invention queries or senses the value of a registry key and selectively modifies the installation according to the sensed attribute. Based on the value of the registry key, one or more setup screens or prompts may be selectively rendered or suppressed from being rendered to the user via an interface. In this way, the user is presented with an automated logical setup prompt flow tailored to the specific system in which the setup is occurring. Thus, where an operating system or other program is being installed in a system having an application suite which renders one or more of the operating system setup choices inapplicable or otherwise invalid, the software tool can easily sense an attribute, such as a registry key, indicating the installed application suite package, and customize the operating system installation prompting accordingly. Accordingly, Jones, *et al.* does not disclose or suggest *a setup component that senses an attribute of a registry of the server computer system*, as claimed.

Furthermore, the Examiner asserts that it is inherent that a setup component is adapted to sense an attribute of a registry associated with a computer system. (See Final Office Action dated August 25, 2005, page 4). Appellants respectfully disagree. Inherency cannot be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Rather, to demonstrate inherency, *the cited document* must show that the natural result flowing from an operation *as taught* would result in the performance of the questioned function. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (emphasis added). Here, the Examiner incorrectly contends that it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system. However, the registry is a database of configuration settings in a Windows-brand operating systems that stores configuration data about the hardware/software environment

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of the computer in which the operating system or application has been installed. Jones *et al.* does not teach or suggest a registry or a registry key. Thus, it is submitted that without a showing by the Examiner that the cited document makes a reference to a registry or its equivalent, no inherency whatsoever can be gleaned from Jones, *et al.* Accordingly, Jones *et al.* does not disclose a setup component adapted to sense an attribute of a registry.

Additionally, the Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. See, *Richardson* at 9 USPQ2d 1913, 1920. This means that in order to establish anticipation under 35 U.S.C. §102, the single document cited must not only expressly or inherently describe each and every limitation set forth in the patent claim, but also the identical invention must be shown in as complete detail as is contained in the claim. The fact that Jones *et al.* fails to provide a registry, let alone *a setup component that senses an attribute of a registry of the server computer system....; selectively provides at least one setup prompt to the user interface component according to the attribute, and selectively installs the software component on the computer system according to the user command*, leads appellants to the inexorable belief and conclusion that Jones *et al.* does not provide an invention identical to that recited in the subject claims.

In view of at least the foregoing, it is readily apparent that Jones, *et al.* does not anticipate or suggest the subject invention as recited in claims 1, 14, 21, 28, 35, 39 and 40 (and claims 2-13, 15-20, 22-27, 29-34, 36-38, 42 and 45-48 which respectively depend there from). Accordingly, this rejection should be reversed.

B. Rejection of Claims 41, 43 and 44 Under 35 U.S.C. §103(a)

Claims 41, 43 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jones, *et al.* (U.S. 5,666,501) in view of Kenner, *et al.* (U.S. 6,314,565). This rejection should be withdrawn for at least the following reasons. Claims 41, 43 and 44 depend from independent claim 40; and the cited references (alone or in combination) do not teach or suggest appellants' claimed invention. In particular, Kenner, *et al.* fails to make up for the aforementioned deficiencies of Jones, *et al.* with respect to independent claim 40. Accordingly, this rejection should be withdrawn.

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C. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-48 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP169US].

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731

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VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1. A software tool for installing a software component on a server computer system, comprising:

a user interface component that renders a plurality of setup prompts to a user and obtains a user command; and

a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, selectively provides at least one setup prompt to the user interface component according to the attribute, and selectively installs the software component on the computer system according to the user command.

2. The software tool of claim 1, the setup component selectively suppresses at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary.

3. The software tool of claim 2, the at least one setup prompt comprises a selection between at least two setup parameters, and the setup component selects one of the at least two setup parameters according to the attribute.

4. The software tool of claim 3, the setup component selectively installs the software component on the computer system using the selected one of the at least two setup parameters.

5. The software tool of claim 4, the attribute comprises data stored in the computer system.

6. The software tool of claim 5, the data comprises a registry key.

7. The software tool of claim 6, the software component comprises one of an operating system and an application.

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8. The software tool of claim 7, the software component comprises a plurality of program components, and the setup component selectively installs at least one of the plurality of program components according to the attribute.

9. The software tool of claim 1, the at least one setup prompt comprises a selection between at least two setup parameters, and the setup component selects one of the at least two setup parameters according to the attribute.

10. The software tool of claim 9, the setup component selectively installs the software component on the computer system using the selected one of the at least two setup parameters.

11. The software tool of claim 10, the attribute comprises a registry key.

12. The software tool of claim 11, the software component comprises one of an operating system and an application.

13. The software tool of claim 12, the software component comprises a plurality of program components, and the setup component selectively installs at least one of the plurality of program components according to the attribute.

14. A software setup tool for performing a setup operation in a server computer system, comprising:

a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package, and selectively provides one of standard prompting and special prompting to a user according to the attribute; and

a user interface component that renders a plurality of setup prompts to a user and obtains at least one setup parameter.

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15. The software setup tool of claim 14, the setup component further selectively performs at least one setup operation according to the at least one setup parameter and the attribute.

16. The software setup tool of claim 15, the attribute comprises a registry key.

17. The software setup tool of claim 16, the setup component further selectively suppresses at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary.

18. The software setup tool of claim 17, the at least one setup prompt comprises a selection between at least two setup parameters, and the setup component selects one of the at least two setup parameters according to the attribute.

19. The software setup tool of claim 18, the setup component selectively installs a software component on the computer system using the selected one of the at least two setup parameters.

20. The software setup tool of claim 16, the setup component one of renders at least one additional setup prompt to the user according to the attribute, and renders at least one substitute setup prompt to the user according to the attribute.

21. A method of performing a setup operation in a server computer system, comprising:

sensing an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package; and selectively providing one of standard prompting and special prompting to a user in association with the setup operation according to the attribute.

22. The method of claim 21, the act of selectively providing one of standard prompting and special prompting comprises:

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rendering a plurality of setup prompts to a user; and
obtaining at least one setup parameter.

23. The method of claim 22, further comprising selectively performing at least one setup operation according to the at least one setup parameter and the attribute.

24. The method of claim 23, the attribute comprises a registry key.

25. The method of claim 22, the act of providing special prompting comprises one of the acts of:

suppressing at least one setup prompt from a user interface component if the attribute indicates the at least one setup prompt is unnecessary;
rendering at least one additional setup prompt to the user interface component;
and
rendering at least one substitute setup prompt to the user interface component.

26. The method of claim 25, the at least one setup prompt comprises a selection between at least two setup parameters and the act of suppressing at least one setup prompt from the user interface component comprises selecting one of the at least two setup parameters according to the attribute.

27. The method of claim 26, selectively performing at least one setup operation comprises selectively installing a software component on the computer system using the selected one of the at least two setup parameters.

28. A computer-readable medium comprising computer-executable instructions for performing a setup operation of a server computer system:

sensing an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package; and
selectively providing one of standard prompting and special prompting to a user in association with the setup operation according to the attribute.

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29. The computer-readable medium of claim 28, wherein the computer-executable instructions for selectively providing one of standard prompting and special prompting comprise computer-executable instructions for:

rendering a plurality of setup prompts to a user; and
obtaining at least one setup parameter.

30. The computer-readable medium of claim 29, further comprising computer-executable instructions for selectively performing at least one setup operation according to the at least one setup parameter.

31. The computer-readable medium of claim 30, the computer executable instructions for sensing an attribute associated with the computer system comprise computer executable instructions for sensing a registry key.

32. The computer-readable medium of claim 29, the computer executable instructions for providing special prompting comprise computer executable instructions for one of:

suppressing at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary; and;
rendering at least one additional setup prompt to the user interface.

33. The computer-readable medium of claim 32, the at least one setup prompt comprises a selection between at least two setup parameters, and the computer executable instructions for suppressing at least one setup prompt from the user interface component comprises computer executable instructions for selecting one of the at least two setup parameters according to the attribute.

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34. The computer-readable medium of claim 33, the computer executable instructions for selectively performing at least one setup operation comprise computer executable instructions for selectively installing a software component on the computer system using the selected one of the at least two setup parameters.

35. A software tool for performing a setup operation in a server computer system, comprising:

means for sensing an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package; and

means for selectively providing one of standard prompting and special prompting to a user in association with the setup operation according to the attribute.

36. The software tool of claim 35, the means for selectively providing one of standard prompting and special prompting comprises:

means for rendering a plurality of setup prompts to a user; and

means for obtaining at least one setup parameter.

37. The software tool of claim 36, the attribute comprises a registry key.

38. The software tool of claim 37, the means for providing special prompting comprises means for one of suppressing at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary and rendering at least one additional setup prompt to a user interface.

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39. A data packet adapted to be transmitted between at least two server processes, comprising:

a setup component that senses an attribute of a registry of the server computer system, which attribute is associated with a low functionality suite package and a higher functionality suite package and selectively provides one of standard prompting and special prompting to a user according to the attribute; and

a user interface component that renders a plurality of setup prompts to a user and obtains at least one setup parameter.

40. A system that facilitates an installation of a server operating system, comprising:

a setup component that senses an attribute of a registry associated with the server operating system, and in accordance with the attribute, selectively provides at least one of standard prompts for loading a standard functionality installation of server components and special prompts for loading a special lower functionality installation of server components; and

a user interface component that renders at least one of the standard prompts and the special prompts, and receives at least one setup parameter.

41. The system of claim 40, the standard functionality installation includes the rendering of a standard prompt that is a licensing page, which licensing page is not rendered during the special lower functionality installation.

42. The system of claim 40, the server operating system is installed in a per server mode when the attribute indicates the special lower functionality installation of server components.

43. The system of claim 42, the per server mode invokes a fixed number of client user licenses.

44. The system of claim 40, the standard functionality installation includes the rendering of a standard prompt that is a licensing page.

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45. The system of claim 40, only the special lower functionality installation requires the rendering of a workgroup/domain page.

46. The system of claim 40, the special lower functionality installation includes installing the server operating system in accordance with a default workgroup.

47. The system of claim 40, the special prompts are included in the standard prompts.

48. The system of claim 40, the special prompts are included in the standard prompts, such that some of the standard prompts are by-passed during the special lower functionality installation in accordance with the attribute.

IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.